

Remarks

In the non-final Office Action mailed February 21, 2007 (“the Office Action”), the U.S. Patent and Trademark Office (“the Patent Office”) acknowledged that claims 2-8, 10, 11, and 13-20 are pending in the application.

In the present Office Action, the Patent Office rejected claims 2-8, 10, 11, and 13-20.

The applicant notes with interest that in the first Office Action dated May 23, 2006, the Patent Office allowed claim 20 and stated that claims 6, 13, 15, 16, 18, and 19 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response to that first Office Action, the applicant amended and canceled claims in order to expedite prosecution of the present application. The Patent Office has now completely reversed course, in spite of the amended and canceled claims, and rejected all of the pending claims, primarily in view of art that was already of record in the application.

The applicant traverses the rejections of the pending claims for the reasons that follow. The claims have also been amended herein in order to expedite prosecution of the present application. The amendments are made without disclaimer of any subject matter, without prejudice to future prosecution, and without presumption that the actions are taken for any reason related to patentability. Support for the amendments can be found throughout the specification as filed.

Rejection of Claims 10, 13, 14, and 17 under 35 U.S.C. § 102(b):

In the Office Action, the Patent Office rejected claims 10, 13, 14, and 17 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,520,169 (Georgieff *et al.*) (the ‘169 patent) for reasons stated in the Office Action. Without acceding to the allegations of the Patent Office, independent claim 13 has been amended herein in order to clarify the nature of the claimed invention. The amendment is made merely to expedite prosecution of the present patent application and is made without disclaimer of any subject matter, without prejudice to future prosecution, and without presumption that the actions are taken for any reason related to patentability.

The applicant respectfully contends that the Patent Office has read too much into the

disclosure of the '169 patent (*see e.g.*, "...the fluid transported between the second and third pressure vessels *inherently exhibits a form of* heat exchange with the surrounding environment..." Office Action, page 2; and "...*suggesting that some sort of* heat exchange occurs..." Office Action, page 2). The '169 patent does not disclose differentially condensing one or more anesthetic agents from water vapor in the waste anesthetic gas. On the contrary, at lines 12-14 of column 6, the '169 patent explicitly states that "[a]fter passing through the purification unit ..., the respiratory gas contains essentially *only* oxygen and xenon." (Emphasis added.) Also, at lines 43-46 of column 5, the '169 indicates that the "third pressure vessel ... is provided within the cooling apparatus [merely] as an *additional reservoir for liquid xenon*." (Emphasis added.)

Nowhere in the '169 patent is there any mention that water vapor is to be removed from the "respiratory gas" after passing through the "sorption filter" or "purification unit" (*i.e.*, element 9 of the '169 patent device). Also, the '169 patent explicitly states that the only compound recovered in the "cooling apparatus" (element 20) is liquid xenon.

Thus, as a matter of law, since the '169 patent does not disclose all of the elements of the invention claimed herein, it cannot possibly anticipate claims 10, 13, 14, and 17 of the present application.

For the foregoing reasons, the applicant respectfully requests reconsideration and withdrawal of the rejection of claims 10, 13, 14, and 17 under 35 U.S.C. § 102(b).

Rejection of claims 2-8 and 20 under 35 U.S.C. § 103(a):

In the Office Action, the Patent Office rejected claims 2-8 and 20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,520,169 (Georgieff *et al.*) in view of U.S. Patent No. 5,558,087 (Psaros *et al.*) (the '087 patent) and U.S. Patent No. 5,676,133 (Hickle *et al.*) (the '133 patent) for the reasons stated in the Office Action.

The numerous failings of the '169 patent as a primary reference are discussed elsewhere herein. Since the '169 patent explicitly discloses that the "respiratory gas" contains "only oxygen and xenon" following passage through the "sorption filter" or "purification unit" of the '169 patent (*i.e.*, element 9 of the '169 patent device), a person skilled in the art would have no need to combine the device of the '087 patent with the device of the '169 patent. At best, a person skilled in the art might consider the device of the '087 patent as part of the "sorption filter" or "purification unit" of

the '169 patent (*i.e.*, element 9 of the '169 patent device). Nowhere in the disclosure of the '169 patent is it mentioned or even suggested that water vapor must be removed from the "respiratory gas" after it has passed through the "sorption filter" or "purification unit" of the '169 patent (*i.e.*, element 9 of the '169 patent device). Nothing in the '087 patent or the '133 patent compensates for this additional failing of the primary reference.

For the foregoing reasons, the applicant respectfully requests reconsideration and withdrawal of the rejection of claims 2-8 and 20 under 35 U.S.C. § 103(a).

Rejection of claim 11 under 35 U.S.C. § 103(a):

In the Office Action, the Patent Office rejected claim 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,520,169 (Georgieff *et al.*) for the reasons stated in the Office Action.

The failings of the '169 patent are discussed elsewhere herein. While, the '169 patent focuses its attention on xenon, it also mentions isoflurane as indicated in the Office Action. However, this mere mention of a known anesthetic agent is simply insufficient to render the invention of claim 11 obvious.

The present application acknowledges that the anesthetic agents isoflurane, desflurane, and sevoflurane, as well as equivalents thereof, were known in the art at the time the application was filed. However, claim 11 depends from claim 13, which is drawn to a novel method for recovering one or more volatile, organic anesthetic agents by, in pertinent part, differentially condensing one or more anesthetic agents from water vapor in a waste anesthetic gas. This invention is simply not disclosed, mentioned, or even suggested in the '169 patent. Thus, since the independent claim from which claim 11 depends is novel, dependent claim 11 itself is novel.

For the foregoing reasons, the applicant respectfully requests reconsideration and withdrawal of the rejection of claim 11 under 35 U.S.C. § 103(a).

Rejection of claims 15, 16, 18, and 19 under 35 U.S.C. § 103(a):

In the Office Action, the Patent Office rejected claims 15, 16, 18, and 19 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,520,169 (Georgieff *et al.*) in view of

U.S. Patent No. 5,558,087 (Psaros *et al.*) for the reasons stated in the Office Action.

The failings of the '169 patent and the '087 patent are discussed elsewhere herein, but are repeated here for the convenience of the Patent Office. Since the '169 patent explicitly discloses that the "respiratory gas" contains "only oxygen and xenon" following passage through the "sorption filter" or "purification unit" of the '169 patent (*i.e.*, element 9 of the '169 patent device), a person skilled in the art would simply not combine the device of the '087 patent with the device of the '169 patent. At best, a person skilled in the art would consider the device of the '087 patent as part of the "sorption filter" or "purification unit" of the '169 patent (*i.e.*, element 9 of the '169 patent device). Nowhere in the disclosure of the '169 patent is it mentioned or even suggested that water vapor must be removed from the "respiratory gas" after it has passed through the "sorption filter" or "purification unit" of the '169 patent (*i.e.*, element 9 of the '169 patent device). Nothing in the '087 patent compensates for the numerous failings of the primary reference. Thus, regardless of the allegations in the Office Action about what is or is not disclosed in the '169 and '087 patents, there is simply no reason for a person skilled in the art to combine them as the Patent Office has done.

For the foregoing reasons, the applicant respectfully requests reconsideration and withdrawal of the rejection of claims 15, 16, 18, and 19 under 35 U.S.C. § 103(a).

Conclusion

The applicant respectfully requests reconsideration of the pending claims in view of the amendments and remarks herein. The amendments are made merely to expedite prosecution of the present patent application and are made without disclaimer of any subject matter, without prejudice to future prosecution, and without presumption that the actions are taken for any reason related to patentability. The Patent Office is invited to contact the undersigned at 312 913 2117, should the Patent Office believe such contact would expedite prosecution of the present application. The undersigned hereby authorizes the Patent Office to debit any fees necessary for this or any future response from Deposit Account No. 13-2490.

The applicant respectfully contends that the pending claims are allowable and respectfully requests the prompt issuance of a Notice of Allowability.

Respectfully,

/Mark L. Chael/

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